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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,905	08/25/2003	Horst Noglik	2600.2.16	2340
21552	7590	06/01/2005	EXAMINER	
MADSON & METCALF GATEWAY TOWER WEST SUITE 900 15 WEST SOUTH TEMPLE SALT LAKE CITY, UT 84101			LEE, SIN J	
			ART UNIT	PAPER NUMBER
			1752	
DATE MAILED: 06/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/647,905	NOGLIK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sin J. Lee	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 25 February 2005.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-14, 16-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 11 and 16-23 is/are allowed.
- 6) Claim(s) 1-10, 12-14 and 25-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicants canceled claims 15 and 24.
2. In view of the Terminal Disclaimer filed on February 25, 2005, previous double patenting rejection on claims 1, 2, 4-9, 12, 14, and 15 over Pat.'691 in view of Inoue et al'433 and previous double patenting rejection on claims 10 and 13 over Pat.'691 in view of Inoue et al'433 and further in view of Bi et al'993 are hereby withdrawn.
3. In Paragraphs 7-8 of previous Office action (mailed on September 23, 2004), the Examiner stated the following in rejecting claims 1-9, 12, 14-22, and 25-28 under 35 U.S.C. 103(a) over Goodin et al'691 in view of Inoue et al'433 and in rejecting claims 10 and 13 under 35 U.S.C. 103(a) over Goodin et al'691 in view of Inoue et al'433 and further in view of Bi et al'993:

*"The applied reference (Goodin'691) has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2)."*

It is to be noted that the Examiner made a mistake in stating that Goodin'691 constitutes prior art *only under 35 U.S.C. 102(e)* with respect to claims 1-10, 12-14, and 25-28, because these claims include the subject matter of "an overcoat elutable in aqueous media", which is *not* present in either of the parent applications 10/338,128 and 09/465,658. Thus, the effective filing date of present application with respect to

those claims is August 25, 2003, and Goodin et al'691 is not a prior art only under 35 U.S.C. 102(e) because the reference, which is published on January 7, 2003, also qualifies as prior art under 35 U.S.C. 102(a). Therefore, the previous 103(a) rejections over Goodin et al'691 in view of Inoue et al'433 are being repeated below (without the statements shown above) with respect to claims 1-10, 12-14, and 25-28, and the rejection is being made *non-final*.

However, for claims 16-22, Goodin'691 is a prior art only under 35 U.S.C. 102(e), and thus applicants' statement of common ownership overcame the previous 103 rejection on those claims.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-9, 12, 14, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodin et al (6,503,691 B1) in view of Inoue et al (6,513,433 B2).

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Goodin et al (6,503,691 B1) at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, reference Goodin et al'691 additionally qualifies as prior art under another subsection of 35 U.S.C. 102, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application,

and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

Goodin teaches (see Example 1, claim 1, col.1, lines 8-17) a lithographic printing plate precursor comprising an aluminum substrate having coated thereon a layer (which becomes less hydrophilic upon exposure to radiation that effects crosslinking in the layer) that comprises a thermosensitive mixture of polyacrylic acid (present crosslinkable polymer), copper sulfadiazine (present thermally active crosslinking metal salt), and an infrared absorbing dye 830A. Goodin does not disclose present overcoat elutable in aqueous media.

Inoue teaches (see col.12, lines 22-52, col.16, lines 8-11) the use of a water-soluble overcoat layer (which is made of water soluble organic polymer and which preferably comprises a water soluble cyanine dye (present aqueous-soluble infrared-absorbing dye of claims 12 and 13) provided on a heat-sensitive layer of lithographic printing plate precursor in order to prevent the surface of the heat-sensitive layer from being contaminated by lipophilic materials. Inoue also teaches that this water-soluble overcoat layer is designed to be easily removed at the time of printing. It would have been obvious to one of ordinary skill in the art to provide a water-soluble overcoat layer (which is made of water soluble organic polymer and which preferably comprises a water soluble cyanine dye) on the thermosensitive layer of Goodin's lithographic printing plate precursor in order to prevent the surface of the heat-sensitive layer from being contaminated by lipophilic materials as taught by Inoue. Therefore, Goodin in view of Inoue would render obvious present inventions of claims 1, 4-9, 12, and 14.

With respect to present claims 2 and 3, Goodin states (col.5, lines 28-30) that the crosskicking reactions of the crosslinkable polymer appear to be interdependent with the crosslinking of the metal compound. Also, claim 10 of Goodin states that the crosslinking reactions of the crosslinkable polymer are independent of the crosslinking of the metal salt. Therefore, Goodin in view of Inoue would render obvious present inventions of claims 2 and 3.

With respect to present claims 25-28, Goodin imagewise-exposes his lithographic printing plate precursor of Example 1 using a power of 10 Watts and an energy of 550 mJ/cm<sup>2</sup> on a Creo Products Inc. Trendsetter laser plate setting machine (an infrared semiconductor laser). Inoue also teaches that the water-soluble overcoat layer is easily removed at the time of *printing*. Therefore, Goodin in view of Inoue would render obvious present inventions of claims 25-28.

6. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodin et al (6,503,691 B1) in view of Inoue et al (6,513,433 B2) as applied to claim 1 above, and further in view of Bi et al (5,997,993).

Although Goodin in view of Inoue teaches an overcoat layer comprising water-soluble organic polymer and an water-soluble IR absorbing dye, Goodin in view of Inoue does not disclose present saccharide compound of claim 10. Bi teaches (col.5, lines 12-25) the use of saccharides in an overcoat layer (for a lithographic printing plate precursor) for the on-press removability of the overcoat layer. Based on Bi's teaching, it would have been obvious to one of ordinary skill in the art to provide an overcoat layer in Goodin's invention which comprises an water-soluble organic polymer and an water-

soluble IR absorbing dye as well as saccharide compound to ensure on-press removability of the overcoat layer as taught by Bi. Therefore, Goodin in view of Inoue and further in view of Bi would render obvious present inventions of claims 10 and 13.

***Allowable Subject Matter***

7. Claims 11 and 16-23 are allowed. Goodin et al'691 in view of Inoue et al'433 do not teach or suggest present overcoat layer that comprises chitosan as presently required in claim 11. Also, Goodin et al'691 does not teach or suggest present silver 2-mercapto-5-amino-1,2,4-thiadiazole of claim 23. Although Overcash et al (6,132,822) teaches a barrier coating composition, which comprises a crosslinkable polymer and a crosslinking agent such as fatty acid complexes of metal ions, the reference does not teach or suggest present IR radiation sensitive dye of claim 16.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*S. f. L.*

S. Lee  
May 30, 2005

*Sin f. Lee*

**SIN LEE**  
**PRIMARY EXAMINER**